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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,685	12/11/2001	Flavio Camerlengo	6537	9190

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ARLENE J. POWERS
GAUTHIER & CONNORS LLP
225 FRANKLIN STREET
SUITE 3300
BOSTON, MA 02110

EXAMINER

HO, UYEN T

ART UNIT PAPER NUMBER

3731

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,685

Applicant(s)

CAMERLENGO, FLAVIO

Examiner

(Jackie) Tan-Uyen T. Ho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 5/13/04 have been fully considered but they are not persuasive. Applicant argued that claim 1 is patently distinguishable from the prior art references because the treatment of the inventive tip is completely different with respect to the improved cutting ability of the needle as indicated on page 5 of the office action. MPEP 2144 under Rationale Different From Applicant's is Permissible – "There is no requirement that the prior art provide the same reason as the applicant to make the claimed invention." The combination of the prior arts indicated in the previous office action make the claimed invention. The introductory statement of intended use and all other functional statements have been carefully considered but are deemed not to impose any structural limitations on the claims distinguishable over the device of Gravlee, Jr. in view of Sastri which is capable of being used as claimed if one desires to do so.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by McIntyre (4,014,333). McIntyre discloses a tip for oculistic surgery including a proximal joint end and a distal end (figures 2) wherein the distal end is coated with tungsten

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carbide (col. 3, lines 39-45). Claim 2 is the product by process claim, determination of patentability is based on the product itself (MPEP 2113) wherein there is not structural different between the tip of the prior art and the present invention. In regard to claim 4, The introductory statement of intended use and all other functional statements such as "is subjected" have been carefully considered but are deemed not to impose any structural limitations on the claims distinguishable over the McIntyre's device which is capable of being used as claimed if one desires to do so.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gravlee, Jr. (5,788,679) in view of Sastri (4,556,607). Gravlee, Jr. disclose an improved phacoemulsification needle including all the limitations as claimed except for a presence of an anti-friction coating as claimed coating on the tip of the needle. Sastri discloses material as claimed for coating on a cutting edge of cutting tool in order to reduce friction to improve the cutting performance of the cutting tool as to improve the wear resistance and corrosion resistance and the hardness of the cutting tool. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention

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was made to employ the coating as disclosed by Sastri into the Gravlee, Jr.'s phacoemulsification needle in order to improve cutting ability of the needle.

5. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nun (6,217,584) in view of Sastri '607. Nun disclose all the limitation of the claims except for presence of a tungsten carbide coating on the tip (246). Sastri discloses material as claimed for coating on a cutting edge of cutting tool in order to reduce friction to improve the cutting performance of the cutting tool as to improve the wear resistance and corrosion resistance and the hardness of the cutting tool. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the coating as disclosed by Sastri into the Nun's drill tip in order to improve cutting ability of the drill tip.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Jackie) Tan-Uyen T. Ho whose telephone number is (703) 306-3421. The examiner can normally be reached on MULTIFLEX Mon. to Sat..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott or Shaver can be reached on 703-308-0858. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



(Jackie) Tah-Uyen T. Ho
Patent Examiner
Art Unit 3731

September 14, 2004